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On 9/8/03
(Date)

Julie H. Gamotis
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Fax: (703) **872-9310** *JCW*
~~305-7115~~ *9/8/03*

KIRIL A. PANDELISEV

Serial No.: 09/881,091

Art Unit: 1731

Filed: June 15, 2001

Examiner: J. Hoffmann

For: HOT SUBSTRATE DEPOSITION FIBER OPTIC PREFORMS AND PREFORM COMPONENTS PROCESS AND APPARATUS

RESPONSE

To the Director of Patents and Trademarks

Sir:

History

In response to the office action dated August 20, 2003,
kindly accept the following.

The first office action required an election between Groups I, II and III.

The applicant selected Group II method claims and traversed the requirement.

The second office action repeated a requirement for election of species and a list of claims.

The applicant supplied an election of species and list of claims.

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The third office action argued that claims in the list did not read on the elected species. Specifically the third office action pointed out:

- Claims 68-72 read on Species C2 feeding a powder, not elected C3 soot generation.
- Claim 103 was identified as not a method claim.
- Claim 137 read on Species N2, final cladding not doped, and not elected N1 final cladding doped.
- Claim 22 did not read upon elected A1, one substrate.
- No method claims read on E1 MCVD. It is understood that VD refers to vapor deposition. MC is understood to mean modified chemical.

Response

Claims 74-77 specifically read on MCVD, for example.

Claims 68-72 read on soot generation. The streaming of particles, heating the particles by a plasma with a neutral gas are a part of generating soot.

Claims 68-72 generate soot in the ordinary meaning of soot related to glass manufacture.

Claim 103 is a product by process claim which depends from a method claim and should be grouped with method claims.

Claim 137 produces an N2 undoped cladding and should not be in the list.

Claim 22 should not be included in exactly one species A1. However, it is believed that in a claim one includes more than 1 and exactly is inappropriate.

Claims 22 and 137 may be delisted.

It is believed that claim 103 is appropriately grouped with method claims but, if the examiner disagrees, 103 may be delisted.

No extension fee is believed to be required, because the office action could have examined claims.

Moreover, the claims result from a single inventive effort and should be examined together.

The applicant traverses the requirement for restriction.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon his holding that the subjects are distinct. That is, as pointed out in Section 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under Section 803 that the claimed inventions:

are able to support separate patents and they are ...
distinct (MPEP Section 806.05-806.05(i)).

However, Section 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

So that Section 803 makes its point clearly, the serious burden requirement is repeated under the title:

CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS

Section 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES that an examiner must provide reasons and/or examples to support conclusions. The examiner has never stated and provided examples that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner. The examiner in this case is a

senior examiner and is well skilled in examining glass manufacturing in Class 65.

With regard to the examiner's specific points, in the following paragraphs it can be seen that restriction is not proper.

2. Groups I and II inventions are not distinct. The two-way distinctiveness required by 806.05(c) cannot be established. The combination as claimed in claim 47 requires the sub-combination as claimed. There is no separate classification, status or field of search as required by 806.05(c), because the subclass, which is noted by the examiner for Group I, II and III, are the same or have not been differentiated by the examiner.

The inventions of Groups I, II and III are not different combinations in that they do not have "different modes of operation" as required by 806.04. Moreover, where inventions are related as disclosed but are not distinct as claimed, restriction is never proper (MPEP 806). The inventions are not distinct as claimed.

4. MPEP 806 provides that if the inventions are not distinct as claimed, restriction is never proper.

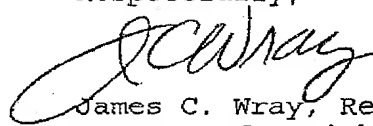
The process as claimed in Group II claims is not distinct from the products as claimed in the Groups I and III claims. The examiner has given no example. Moreover, Section 806.05(h) emphasizes "as claimed" and falls under the cautions of 806 and 806.05, both of which state, "where the

inventions are related as disclosed but are not distinct as claimed, restriction is never proper". In the present case the particular criteria and guidelines of 803 must be followed in that there must be a serious burden on the examiner if restriction were not required. In the present case, all of the groups must be searched in all of the subclasses which the examiner has pointed out. All are properly classified and searched together, and the search for one group would not be complete without searching all of the subclasses that the examiner has pointed out.

Patent and Trademark Office records indicate that the number of patents in the classes noted by the examiner is not excessive and would not suggest a hardship. There should be no hardship on the examiner to complete examination for all groups.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction requirement are requested.

Respectfully,



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